

Election / Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C.

121:

- I. Claim 56 – 87, 91, 94, 96, 100, 107, 108, drawn to remote control over telephone lines, classified in class 379, subclass 74.
- II. Claim 88 – 90, 92, 93, 95, 97 – 99, 106, 109, 110, drawn to a control system with plural processors, classified in class 700, subclass 2.

2. Inventions I and II are related as combination and subcombination.

Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not required the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combination (MPEP § 806.05 (c)). In the instant case, the combination as claimed does not required the particulars of the subcombination as claimed because invention II (computer control system) does not require the particulars of the invention I. The subcombination has separated utility such as telephone dial tone or pulses.

Because these inventions are distinct for the reason given above and have acquired a separated status in the art as shown by their different classification, restriction for examination purpose as indicated is proper.

**806.05(c) Criteria of Distinctness for Combination, Subcombination,
or Element of a Combination - 800 Restriction in Applications Filed
Under 35 U.S.C. 111; Double Patenting**

**806.05(c) Criteria of Distinctness for Combination, Subcombination,
or Element of a Combination**

In order to establish that combination and subcombination inventions are distinct, two-way distinctness must be demonstrated.

To support a requirement for restriction, both two-way distinctness and reasons for insisting on restriction are necessary, i.e., separate classification, status, or field of search. See **MPEP § 808.02**.

The inventions are distinct if it can be shown that a combination as claimed:

(A) does not require the particulars of the subcombination as claimed for patentability (to show novelty and unobviousness), and

(B) the subcombination can be shown to have utility either by itself or in other and different relations.

When these factors cannot be shown, such inventions are not distinct.

The following examples are included for general guidance.

I. SUBCOMBINATION NOT ESSENTIAL TO COMBINATION

AB

br

/B

sp

Restriction Proper

Where a combination as claimed does not set forth the details of the subcombination as separately claimed and the subcombination has separate utility, the inventions are distinct and restriction is proper if reasons exist for insisting upon the restriction; i.e., separate classification, status, or field of search.

This situation can be diagrammed as combination AB

br

("br" is an abbreviation for "broad"), and subcombination B

sp

("sp" is an abbreviation for "specific"). B

br

indicates that in the combination the subcombination is broadly
recited and that the specific characteristics set forth in the
subcombination claim B

sp

are not set forth in the combination claim.

Since claims to both the subcombination and combination are
presented and assumed to be patentable, the omission of details of
the claimed subcombination B

sp

in the combination claim AB

br

is evidence that the patentability of the combination does not rely
on the details of the specific subcombination.

II. SUBCOMBINATION ESSENTIAL TO COMBINATION

AB

sp

/B

sp

No Restriction

If there is no evidence that combination AB

sp

is patentable without the details of B

sp

, restriction should not be required. Where the relationship between the claims is such that the separately claimed subcombination B

sp

constitutes the essential distinguishing feature of the combination AB

sp

as claimed, the inventions are not distinct and a requirement for restriction must not be made, even though the subcombination has separate utility.

III. SOME COMBINATION CLAIMS RECITE SPECIFIC FEATURES OF THE SUB-COMBINATION BUT OTHER COMBINATION CLAIMS GIVE EVIDENCE THAT THE SUBCOMBINATION IS NOT ESSENTIAL TO THE COMBINATION.

AB

sp

/AB

br

(Evidence Claim)/B

sp

Restriction Proper

Claim AB

br

is an evidence claim which indicates that the combination does not rely upon the specific details of the subcombination for its patentability. If claim AB

br

is subsequently found to be unallowable, the question of rejoinder of the inventions restricted must be considered and the letter to the applicant should so state. Therefore, where the combination evidence claim AB

br

does not set forth the details of the subcombination B

sp

and the subcombination B

sp

has separate utility, the inventions are distinct and restriction is proper if reasons exist for insisting upon the restriction.

In applications claiming plural inventions capable of being viewed as related in two ways, for example, as both combination-subcombination and also as different statutory categories, both applicable criteria for distinctness must be demonstrated to support a restriction requirement. See also **MPEP § 806.04(b)**.

Form paragraph 8.15 may be used in combination-subcombination restriction requirements.

8.15 Combination-Subcombination

Inventions [1] and [2] are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (**MPEP § 806.05(c)**). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because [3]. The subcombination has separate utility such as [4].

Examiner Note